Appl. No.:   09/766,007
Amdt. dated May 21, 2004
Reply to Office action of February 9, 2004

REMARKS/ARGUMENTS

Applicants received the Office Action in which the Examiner: (1) objected to the length of the Abstract; (2) rejected claims 1, 12, 15, and 18 under 35 U.S.C. § 112, second paragraph; (3) rejected claims 1-8 as obvious over the commercial product OpenView as documented in the 1995 publication by Muller entitled "Focus On OpenView: A Guide to Hewlett-Packard's Network and System Management Platform;" (4) rejected claims 12-13 as anticipated under § 102(b) by Kroening (U.S. Pat. No. 6,080,207); (5) rejected claim 14 as obvious over Kroening in view of Beelitz (U.S. Pat. No. 6,470,446); (6) rejected claims 15-16 as anticipated under § 102(e) by Beelitz; (7) rejected claim 17 as obvious over Kroening in view of "common knowledge of programming;" (8) rejected claims 9-11 and 18-19 as anticipated under § 102(b) by OpenView; and (9) rejected claim 20 as obvious over OpenView. The Examiner also requested, under 37 CFR 1.105, the date of first use and/or first sale of "HP Windows XP Recovery System."

In this Response, Applicants amend the Abstract and claims 1, 3, 12, and 15. Applicants also cancel claims 2, 4-11, 13, and 18-20. Applicants also address the Examiner's Request for Information under 37 CFR 1.105. Based on the amendments and arguments contained herein, Applicants believe all pending claims to be in condition for allowance.

I.   THE ABSTRACT OBJECTION

The Examiner objected to the length of the Abstract. The Abstract has been amended to comprise 150 words or fewer.

II.   THE CLAIM OBJECTIONS

The Examiner objected to various references to the "user interface" in claims 1, 12, 15, and 18. These references have been changed to "user interface application." Applicants believe these amendments fully address the Examiner's concerns.

III.   THE CLAIM REJECTIONS

Applicants amend the preamble of claim 1 to clarify that the claim pertains to a manufacturing method. Further, Applicants amend claim 1 to require that the

121490.03/2162.25600   Page 6 of 11   HP PDNO 10001946-1

bootable software is capable of erasing the installation software bundles in the second partition. Applicants contend that the art of record does not teach or even suggest that OpenView is to be used in the manufacturing context as claimed, much less to be used to overwrite bootable software and a user interface and to erase various installation software bundles in a second partition. At least for these reasons, Applicants believe claim 1 and its dependent claims are allowable[1].

Independent claim 12 is directed to a computer whose storage media is partitioned into first and second partitions. The first partition contains bootable software and a user interface application that permits a user to select which image-based software bundle on the second partition should be installed. Further, the bootable software and user interface are overwritten when the selected bundle is being installed. Further still, the installation software bundles themselves are erased. Claim 12 is amended to clarify that the claim pertains to a computer and to storage media of the computer. Further, claim 12 is amended to clarify that the reference to a "user" pertains to a user "of the computer."

Kroening discloses that a purchaser selects software to be loaded on to a computer. A computerized system creates a disk image of the desired software configuration and transfers the image to a storage device. An image server transfers the disk image to a hard drive of the purchaser's computer. See Abstract. Kroening does not disclose a computer that contains a storage medium that contains software that can perform the various acts recited in the claim. By contrast, Kroening relates to a system as depicted in Figure 1 that comprises multiple computers at a factory interacting with one another to provide the software on a purchaser's computer that the purchaser requests. Claim 12, on the other hand, places the functionality of providing the software that a purchaser might want and the ability for a user to select the desired software all within the confines of a computer. Applicants also do not find that Kroening discloses overwriting the bootable software and user interface application as well as

---

[1] Applicants removed the word "installation" from claim 3 to ensure proper antecedent basis.

erasing the installation software bundles as claimed. At least for these reasons, claim 12 and its dependent claims are patentable.

Applicants eliminated unnecessary language from the preamble of claim 15. Further, amended claim 15 requires, among other features, "giving a user an opportunity to select...one from a plurality of software bundles to install in the computer, each of the software bundles being stored in form as an image...in a second partition of storage of the computer." Beelitz pertains to a method of formatting a hard drive. In the method of Beelitz, "the system network administrator is prompted for disk preparation data, including the type of network OS, and primary partition size, utility partition size, and volume label for the hard disk 16." Col. 2, lines 55-58. Beelitz does not disclose permitting a user the opportunity to select one of a plurality of image-based software bundles that are already stored in the computer. At least for this reason, claim 15 and dependent claims 16 and 17 are allowable over Beelitz.

IV.   THE 37 CFR 1.105 REQUEST FOR INFORMATION

To be best of the undersigned's knowledge, the HP Windows XP Recovery System was first commercially made available after the filing date of the present application. Documentation establishing this fact is not readily available.

V.   STATEMENT OF THE SUBSTANCE OF THE INTERVIEW

In a telephonic interview conducted on May 18, 2004, between Examiner Todd Ingberg (USPTO), Jonathan M. Harris (Reg. No. 44,144) and Tracy Evans (Inventor), OpenView was discussed as well as the claims. The Examiner suggested focusing on the "destructive" nature of the claimed methods and apparatus. The Request for Information was also discussed and Applicants' response is provided above.

VI.   CONCLUSION

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining

Appl. No.:   09/766,007
Amdt. dated May 21, 2004
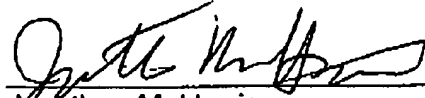**Reply to Office action of February 9, 2004**

the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the prior art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. If any fees or time extensions are inadvertently omitted or if any fees have been overpaid, please appropriately charge or credit those fees to Hewlett-Packard Company Deposit Account Number 08-2025 and

121490.03/2162.26800   Page 9 of 11   HP PDNO 10001946-1

Appl. No.:   09/766,007
Amdt. dated May 21, 2004
Reply to Office action of February 9, 2004

enter any time extension(s) necessary to prevent this case from being abandoned.

Respectfully submitted,

Jonathan M. Harris
PTO Reg. No. 44,144
CONLEY ROSE, P.C.
(713) 238-8000 (Phone)
(713) 238-8008 (Fax)
ATTORNEY FOR APPLICANTS

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
Legal Dept., M/S 35
P.O. Box 272400
Fort Collins, CO 80527-2400

121490.03/2162.25600   Page 10 of 11   HP PDNO 10001946-1